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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,894	08/25/2000	Peter L. Katsikas	PKAY-P1	6988

7590 07/02/2004
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EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/648,894

Applicant(s)

KATSIKAS, PETER L.

Examiner

Brandon Hoffman

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Rejections

1. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 21-23, 28-34, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (U.S. Patent No. 5,931,905) in view of Paul (U.S. Patent No. 6,052,709).

Regarding claims 21, 32, and 40, Hashimoto et al. teaches a method/system for eliminating unauthorized email on a network comprising the steps of:

- Establishing a connection on a network between an email-receiving server and an email-sending server (fig. 17, ref. num 20A and 20B);
- Making accessible to the email-receiving server for each subscribing user an authorized senders list (ASL list) of email addresses of external users **authorized/not authorized** to send email to the user (col. 12, lines 42-50 and col. 13, lines 5-9),
- Receiving at the email-receiving server a message from the email-sending server requesting to send email which is addressed to a user deemed to receive email through the email-receiving server and which is addressed from a given sender address (col. 10, lines 31-44);

- Causing the email-receiving server to check whether the user the intended email is addressed to is a user which receives email through the email-receiving server, and, if so, then causing the email-receiving server to check whether the sender address of the intended email is on the user's ASL list of external users not authorized to send email to the user (col. 12, lines 38-41); and
- If the sender address of the intended email is recognized as being on the user's ASL list, causing the email-receiving server to send a reply message to the email-sending server that the sending of the email to the email-receiving server will be accepted, otherwise if the sender address of the intended email is not recognized as being on the user's ASL list, causing the email-receiving server to send an error message to the email-sending server that the email-receiving server will not accept the sending of the email to the email-receiving server (col. 12, line 62 through col. 13, line 4).

Hashimoto et al. does not teach wherein said email-receiving server and email-sending server utilize a common email-sending system protocol to send email on the network.

Paul teaches wherein said email-receiving server and email-sending server utilize a common email-sending system protocol to send email on the network (col. 9, lines 22-40).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine wherein said email-receiving server and email-sending server utilize a common email-sending system protocol to send email on the network, as taught by Paul, with the method/system of Hashimoto et al. It would have been obvious to combine wherein said email-receiving server and email-sending server utilize a common email-sending system protocol to send email on the network, as taught by Paul, with the method/system of Hashimoto et al. because checking and eliminating email spam at the SMTP server reduces data traffic flow on a communications link before it is stored (see col. 9, lines 27-30 of Paul).

Regarding claims 22 and 33, Hashimoto et al. in view of Paul teaches wherein the ASL module includes:

- An ASL database for storing ASL lists of both authorized and non-authorized sender addresses for respective users of the email-receiving server (see col. 12, lines 37-41 and col. 13, lines 5-9 of Hashimoto et al.),
- A spam processor module for checking the ASL lists for matches (see col. 12, line 67 through col. 13, line 4 of Hashimoto et al.), and
- An ASL manager for creating, maintaining, and updating the ASL lists (see col. 12, lines 43-48 of Hashimoto et al.).

Regarding claims 23 and 34, Hashimoto et al. in view of Paul teaches wherein a redirector module is provided to operate with the ASL module:

- For receiving the message from the email-sending server requesting to send email designating the sender's FROM address and intended recipient's TO address (see fig. 7, "SENDER" and "DESTINATION" of Hashimoto et al.),
- For sending a request for validation to the spam processor module to determine whether the sender's FROM address matches any authorized sender address maintained on the ASL list corresponding to the TO address of the intended recipient (see col. 12, lines 62-67 of Hashimoto et al.),
- For sending the reply message accepting the email from the email-sending server if a match to an authorized sender address is found (see col. 12, line 67 through col. 13, line 1 of Hashimoto et al.), and
- For sending the error message not accepting the email if no match to an authorized sender address is found on the ASL list (see col. 13, lines 2-4 of Hashimoto et al.).

Regarding claims 28, 29, and 37, Hashimoto et al. in view of Paul teaches wherein email addresses used on email sent by a user which receives email through the email-receiving server and other addresses accessed by the user on the network are captured and stored with the ASL manager for later analysis (fig. 17, ref. num 25 of sending and receiving end); and wherein the ASL manager analyzes the captured addresses using a rules processor for processing predefined address capture rules for updating the ASL lists using data from an email address source selected from the group of email address sources consisting of: received email; sent email; user inputs to email

service functions on the email client; inputs from user browsing of web sites; user desktop organizer and other contact lists; and third party address program inputs (see fig. 57, ref. num 41 and col. 23, lines 24-67 of Hashimoto et al.).

Regarding claims 30 and 38, Hashimoto et al. in view of Paul teaches wherein the ASL manager analyzes the captured addresses using a rules processor for processing predefined analysis rules for updating the ASL lists using data from an analysis source selected from the group of analysis sources consisting of: user email log analysis; expiration date analysis; low/high email volume analysis; fuzzy logic analysis; and third party data analysis (Applicant states, on page 4, first paragraph, of the preliminary amendment received on August 23, 2001, "all email systems, like the Hashimoto system only scans the FROM and TO addresses of the subscriber's email in order to maintain a log identifying the email the subscribers has sent and received." This admission suggests that the Hashimoto et al. patent, as well as other patents and publications, discloses the ASL manager selects from the group of analysis sources consisting of user email log analysis. This clearly labels the above claims as unpatentable based over a prior art teaching.).

Regarding claims 31 and 39, Hashimoto et al. in view of Paul teaches wherein the ASL manager maintains the ASL lists to designate a sender-address status for each sender address selected from the group of sender-address statuses consisting of: always authorized as a friend; authorized as a friend over a date range; authorized as a

friend before an expiration date; always rejected as a spammer; rejected as a spammer matching a black list; and rejected as a spammer sent with an error message (see col. 13, lines 5-24 of Hashimoto et al.).

Claims 24-27, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (USPN '905) in view of Paul (USPN '709), and further in view of Lillibridge et al. (U.S. Patent No. 6,195,698).

The combination of Hashimoto et al. in view of Paul teaches wherein the WBM module sends a message to the address of the sender of the non-accepted email notifying the sender to confirm with the WBM module that the sender is a legitimate sender of email to the intended recipient (see col. 13, lines 2-4 of Hashimoto et al.). However, Hashimoto et al. in view of Paul does not teach wherein a web-based messaging (WBM) module is provided to which the sender of intended email that is not accepted by the email-receiving server is redirected by the redirector module.

Lillibridge teaches wherein a web-based messaging (WBM) module is provided to which the sender of intended email that is not accepted by the email-receiving server is redirected by the redirector module (fig. 5).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a WBM module to confirm that a sender is a legitimate

sender of email to the intended recipient, as taught by Lillibridge et al., to the method/system of Hashimoto et al./Paul. It would have been obvious to one of ordinary skill in the art to combine a WBM module to confirm that a sender is a legitimate sender of email to the intended recipient, as taught by Lillibridge et al. to the method/system of Hashimoto et al./Paul because most SPAM messages are generated by a machine/agent to distribute to thousands of email addresses. The WBM module will prevent non-human messages from getting to a receivers inbox, thus reducing the hassle of SPAM (see col. 9, lines 3-8 of Lillibridge et al.).

This new method/system, as taught by the combination of Hashimoto et al./Paul and Lillibridge et al. would cause an unregistered email account to be authenticated by the WBM module. This module would force a sender to type in humanly perceptible characters to verify the sender is indeed a human. After correctly typing in the characters, the sender would be allowed to send a message to the intended recipient.

Regarding claim 25, Hashimoto et al./Paul as modified by Lillibridge et al. teaches wherein the WBM module is a website accessible on the network which invites the notified sender to log on and confirm that the sender is a legitimate sender of email through an interaction procedure which can only be performed by a human (see col. 5, lines 41-43 and col. 6, lines 11-16 of Lillibridge et al.).

Regarding claim 26, Hashimoto et al./Paul as modified by Lillibridge et al. teaches wherein the interaction procedure includes a display of a graphic image of a

word in a non-standard font, and a prompt to the sender to enter in a word corresponding to the graphic image of the word, whereby the system can confirm that the interaction procedure is not performed by a mechanical program (see fig. 4, ref. num 410 & 420 and col. 5, lines 65-67 of Lillibridge et al.).

Regarding claims 27 and 36, Hashimoto et al./Paul as modified by Lillibridge et al. teaches wherein once the sender is confirmed as a legitimate sender of email to the intended recipient user, the WBM website sends a message to the redirector module at the user's email-receiving server that the sender is confirmed as a legitimate sender by the WBM website (see col. 6, lines 64-67 of Lillibridge et al., in this case, the request, Q, is to send a message to the recipient.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2136

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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